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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/067,881	02/08/2002	Noboru Yokota	991183B	8327
38834	7590	06/01/2004	EXAMINER	
WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036			DO, THUAN V	
			ART UNIT	PAPER NUMBER
			2825	

DATE MAILED: 06/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Applicati n No. 10/067,881	Applicant(s) <b>OK</b> YOKOTA ET AL.	
	Examin r Thuan Do	Art Unit 2825	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2002.  
2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☒ Claim(s) 14 is/are allowed.  
6) ☒ Claim(s) 1-5 is/are rejected.  
7) ☒ Claim(s) 6-13 and 16 is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 02 August 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/26/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

1. Claims 1-16 are pending in this office action.

### ***Claim objections***

Claim 1, the terms "impurity" and "missing" are unclear to what they mean. Clarification or correction is required.

Claim 1, line 3 is suggested to put a comma after the word "region" such as  
- - ...region, part of... - -.

Claim 4, line 3 is suggested to put a comma after the word "gate" such as  
- - ...gate, part of... - -.

### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 4 are rejected under the judicially created doctrine of double patenting over claims 1 and 4 respectively of U. S. Patent No. 6555853 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

Although the claims are not identical, they are not patentably distinct from each other because all the recite limitations are found in the claims 1 and 4 of U.S. Patent 6555853.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in-  
(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or  
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

3. Claims 1-5,15 are rejected under 35 U.S.C. 102(e) as being unpatentable over Muruta et al. Pat. No. 5917211.

**Regarding claim 1:** Muruta teaches a device comprising:

A semiconductor device having an embedded array (col. 4, lines 29-39), said embedded array having basic cells arranged in a matrix (col. 12, lines 37-49), wherein a

basic cell has an impurity region part of which is removed (col. 3, lines 49-58), said part corresponding with a missing contact hole (col. 40, lines 47-67 using partial etching portion of contact hole).

**Regarding claim 2:** According to claim 1, Muruta teaches a device with a part of a transistor (col. 3, lines 49-58).

**Regarding claim 3:** According to claim 1, Muruta teaches a device with a substrate (col. 4, lines 22-28).

**Regarding claim 4:** Muruta teaches a device comprising:

A semiconductor device having an embedded array (col. 4, lines 29-39), said embedded array having basic cells arranged in a matrix (col. 12, lines 37-49), wherein a basic cell has a gate part of which is removed (col. 2, lines 10-45 and col. 3, lines 49-58 ), said part corresponding with a missing contact hole (col. 40, lines 47-67).

**Regarding claims 5 and 15:** These claims teach a method similar to claim 1 and rejected in similar manner except the design stage is matched in figure 7 or modifying layout is in column 50, lines 15-30.

#### ***Allowable Subject Matter***

Claims 6-13 and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The reason for allowance is that the prior art of record fails to teach the combination of dependent claims and all other features of corresponding independent claims.

#### ***Allowable Subject Matter***

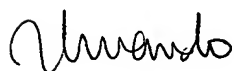
Claim 14 is allowed. The reason for allowance is that the prior art of record fails to teach manufacturing a semiconductor integrated circuit from which a non-use area is removed by substituting said mask having said modified layout for a mask before modification in combination of all features of independent claim.

### **CONTACT INFORMATION**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuan Do whose telephone number is 571-272-1891. The examiner can normally be reached on Monday-Friday 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew S. Smith can be reached on 571-272-1907. The fax phone numbers for the organization where this application or proceeding is assigned are 703 305-3431 for regular communications and 703-305-3431 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0596.



Thuan Do  
Patent examiner  
5/26/04